

No. 11,965

IN THE  
United States Court of Appeals  
For the Ninth Circuit

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LANE-WELLS COMPANY  
(a corporation),

vs.

M. O. JOHNSTON OIL FIELD SERVICE  
CORPORATION (a corporation),

*Appellant,*

*Appellee.*

ANSWERING BRIEF FOR PLAINTIFF-APPELLEE  
(M. O. Johnston Oil Field Service Corporation).

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FILED

APR 8 - 1949



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**SUMMARY OF THE ARGUMENT.**

A patent is subject to the same rules of construction as other contracts, and a Court may properly, if it deems necessary to maintain the validity of the patent, narrowly construe the claims and thus find non-infringement.

*Goodyear Dental Vulcanite Co. v. Davis*, 102

U.S. 222, 26 L. Ed. 149;

*Greenawalt v. Am. Smelting, etc., Co.* (C.C.A. 9), 10 Fed. (2d) 98;

*McEwan Bros. Co. v. McEwan*, 91 Fed. 787, at 790;

*Bragg-Kliesrath Corp. v. Walter S. Vogel & Co.* (C.C.A. 2), 67 Fed. (2d) 531;  
*Henry v. Los Angeles*, 255 Fed. 769.

The apparatus disclosed in the patent in suit is constructed and has a mode of operation entirely different from the construction and mode of operation of the accused apparatus. Consequently, there can be no infringement.

*McDonough v. Johnson-Wentworth Co.* (C.C.A. 8), 30 Fed. (2d) 375, at 383;  
*Wilson & Willard Mfg. Co. v. Union Tool Co.* (C.C.A. 9), 249 Fed. 729;  
*American Can Co. v. Hickmott Asparagus Canning Co.* (C.C.A. 9), 137 Fed. 86;  
*Pacific States Electric Co. v. Wright* (C.C.A. 9), 277 Fed. 756;  
*Measuregraph Co. v. Grand Rapids Show Case Co.* (C.C.A. 8), 29 Fed. (2d) 263.

The District Court did not (as contended by appellant Lane-Wells) base its decision of non-infringement solely on the fact that no practical apparatus was ever built in accordance with the patent, but the District Court in addition based its decision of non-infringement upon its finding of fact that the accused apparatus is substantially different in construction and mode of operation from the apparatus disclosed in the patent in suit. Consequently, the District Court properly concluded as a matter of fact and law, in that the accused apparatus was substantially different in construction and mode of operation from the patent



in suit, a charge of infringement could not be sustained.

*McDonough v. Johnson-Wentworth Co.* (C.C.A. 8), 30 Fed. (2d) 375, at 383;

*Wilson & Willard Mfg. Co. v. Union Tool Co.* (C.C.A. 9), 249 Fed. 729;

*American Can Co. v. Hickmott Asparagus Canning Co.* (C.C.A. 9), 137 Fed. 86;

*Pacific States Electric Co. v. Wright* (C.C.A. 9), 277 Fed. 756;

*Measuregraph Co. v. Grand Rapids Show Case Co.* (C.C.A. 8), 29 Fed. (2d) 263.

The District Court also based its finding of non-infringement on the fact that no apparatus for practical use constructed according to the patent has ever been built and commercially used. The Court's reasons for such a ruling and a consequent limiting of the claims of the patent in suit were based upon the Court's finding of fact that under normal and usual circumstances the device of the Lane patent in suit would be impractical in industry to recover and bring to the surface of a well a beneficial test sample.

The Court having determined that the patent added nothing to the practical art, it was correct in construing the patent as narrowly as it possibly could, and obviously, when so construed, there could be no infringement by the accused apparatus.

*McRoskey v. Braun Mattress Co.* (C.C.A. 9), 107 Fed. (2d) 143;

*Carl Braun, Inc. v. Kendall-Lamar Corporation* (C.C.A. 2), 116 Fed. (2d) 663.

In so construing the patent claims and in finding non-infringement, the Court followed the well established rule of patent law which has been followed for many years by this Court that to find infringement there must be in the patented device and in the accused apparatus (1) identity of result; (2) identity of means for attaining that result; and (3) identity of mode of operation.

*McDonough v. Johnson-Wentworth Co.* (C.C.A. 8), 30 Fed. (2d) 375, at 383;

*Wilson & Willard Mfg. Co. v. Union Tool Co.* (C.C.A. 9), 249 Fed. 729;

*American Can Co. v. Hickmott Asparagus Canning Co.* (C.C.A. 9), 137 Fed. 86;

*Pacific States Electric Co. v. Wright* (C.C.A. 9), 277 Fed. 756;

*Measuregraph Co. v. Grand Rapids Show Case Co.* (C.C.A. 8), 29 Fed. (2d) 263.

It is the contention of appellant, Lane-Wells, that the claims read literally on the accused apparatus. Even granted that this is true, this Court has ruled and in so doing has followed the weight of authority that infringement is not a mere matter of words and is proved simply by language used in a claim without regard to the specifications. Infringement must be proved by showing that the claim covers what is alleged to infringe, when the claims are interpreted by the specifications which describe the invention.

*Westinghouse v. Boyden*, 170 U.S. 537, at 568;  
*Grant v. Koppl*, 99 Fed. (2d) 106;

*Electro-Dynamic Co. v. U. S. Light & Heat Corp.* (C.C.A. 2), 278 Fed. 80, at 84.

**PRELIMINARY.**

In a separate appeal, the appellee herein\* urges that the Lane patent in suit is totally invalid on several well-founded grounds, all based upon the Findings of Fact of the District Court. We urge that this present appeal be determined on the ground that the patent is invalid and consequently there can be no infringement thereof, and for the argument on invalidity, we respectfully refer to our opening brief on behalf of Johnston, who is the appellee here.

Appellant Lane-Wells' brief is based solely upon but one premise which, as we will point out hereinafter, is a false premise. That premise, as we understand it, is based upon appellant Lane-Wells' contention that the *only reason* for the District Court limiting the claims of the patent to a device constructed in accordance with the specification and drawings of the patent in suit, was that no practical device had ever been made in accordance with the teachings of the patent in suit.

Appellant Lane-Wells, in its brief, totally disregards the District Court's finding of fact that the accused apparatus is constructed and has a mode of operation entirely different from that of the apparatus of the patent in suit. From this finding the District Court concluded that no infringement could possibly be found.

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\*The appellee will be referred to herein as appellee Johnston and appellant will be referred to herein as appellant Lane-Wells to avoid confusion because in the cross appeal the appellee herein is referred to as appellant Johnston and the appellant is referred to as appellee Lane-Wells.

A PATENT IS SUBJECT TO THE SAME RULES OF CONSTRUCTION AS OTHER CONTRACTS AND A COURT MAY, IF NECESSARY TO MAINTAIN THE VALIDITY OF THE PATENT, NARROWLY CONSTRUER THE CLAIMS AND THUS FIND NON-INFRINGEMENT.

The following is quoted from *Walker on Patents*, Deller's Edition, Volume Two, page 1204, § 240:

“A patent is subject to the same general rules of construction as other contracts. (Goodyear Dental Vulcanite Co. v. Davis, 102 U.S. 222, 26 L. Ed. 149; Kelly Well Co. v. Kirschke Concrete Well Co., 14 F. (2d) 274, C.C.A. 8 (1926); Tompkins-Hawley-Fuller Co. v. Holden, 273 Fed. 424, C.C.A. 2 (1921); Minneapolis, etc. R. Co. v. Barnett, etc., Co., 257 Fed. 302, C.C.A. 8 (1919); O'Brien-Worthen Co. v. Stempel, 209 Fed. 847, C.C.A. 8 (1913); Motion Picture Patents Co. v. Independent Moving Pictures Co., 200 Fed. 411, C.C.A. 2 (1912); O. H. Jewell Filter Co. v. Jackson, 140 Fed. 340, C.C.A. 8 (1905); National Hollow B. B. Co. v. Interchangeable B. B. Co., 106 Fed. 693, C.C.A. 8 (1901); Elgin Co-op. Butter-Tub Co. v. Creamery Package Mfg. Co., 80 Fed. 293, C.C.A. 7 (1897).)

“The entire instrument, including the drawings and specifications, should be considered in construing a patent. (Hogg v. Emerson, 6 How. (47 U.S.) 437, 12 L. Ed. 505, 11 How. (52 U.S.) 587, 13 L. Ed. 824; Greenawalt v. Am. Smelting, etc., Co., 10 F. (2d) 98, C.C.A. 9 (1926); International Banding Mach. Co. v. Amer. Bander Co., 9 F. (2d) 606, C.C.A. 2 (1925); Horton Mfg. Co. v. White Lily Mfg. Co., 213 Fed. 471, C.C.A. 7 (1913); O'Brien-Worthen Co. v. Stempel, 209 Fed. 847, C.C.A. 8 (1913); Faultless Rubber Co.

v. Starr Rubber Co., 202 Fed. 927, C.C.A. 6 (1913).

\* \* \* \* \*

“These are the declarations of the Supreme Court relevant to the proper liberality to be observed in construing patents. That liberality as often shows itself in a narrow construction as in a broad one; for narrow construction may be as necessary to establish the validity of a patent, as a broad construction is to lay the foundation for proof of its infringement. (McEwan Bros. Co. v. McEwan, 91 Fed. 787, 790, C.C., N. J.) Therefore when it becomes necessary to construe a claim narrowly, in order that its novelty may not be negated by the prior art, or its validity otherwise overthrown, courts will give such a narrow construction, if they can do so consistently with the language of the claim and of the description. (Klein v. Russell, 19 Wall. (86 U.S.) 433, 466, 467, 22 L. Ed. 116; Consolidated Roller-Mill Co. v. Coombs, 39 Fed. 25, 30, C.C. Mich.; Steam Gauge & Lantern Co. v. Williams, 50 Fed. 931, 932, C.C.A. 2; Van Ness v. Layne, 213 Fed. 804, 807-8, C.C.A. 5; Fowler & Wolfe Mfg. Co. v. M’Crum Howell Co., 215 Fed. 905, C.C.A. 2 (1914); Black & Decker Co. v. Baltimore Truck Tire Service Co., 40 F. (2d) 910, 914, C.C.A. 4 (1930); Bragg-Kliesrath Corp. v. Walter S. Vogel & Co., 67 F. (2d) 531, 532, C.C.A. 2 (1933).)”

Undoubtedly, the District Court attempted to sustain the validity of the patent and could do so only by narrowing the claims to the precise apparatus disclosed in the specification thereof, and when so narrowed, had to find non-infringement. The Court in so doing, added no elements to the claims nor sub-



tracted any. It merely construed the broad elements as having a construction and mode of operation disclosed in the specification and claims. This is consistent with the above authorities. It is also consistent with this Court's ruling in *McRoskey v. Braun Mattress Co.*, 107 Fed. (2d) 143. In that case the claims merely claimed "depressing members" of the frames. The claims did not specify whether these members were conical-shaped or not. In construing the claims, this Court referred to the specifications and found that the specification defined those "members" as being "conical-shaped" and consequently construed the claims as meaning "conical-shaped depressing members."

The district judge in the case at bar followed the same rule of construction, in that the claims did not specify what type of a gun the claims called for. In effect the District Court construed that element (the gun) as being a gun of the construction and mode of operation disclosed in the specification. Further, inasmuch as the claim did not specify what type of "a sample taking device or receiver", the Court in effect interpreted that element as being constructed and operated in accordance with the specifications. Then the District Court, finding that when so construed, the accused apparatus not being constructed and operated at all similarly to such a gun and sample receiver, could not possibly infringe the same.

We urge, therefore, as a matter of law, that the Court's ruling of non-infringement should not be disturbed.

ON PAGES 11 AND 12 APPELLANT, LANE-WELLS, ATTEMPTS TO ESTABLISH THAT THE ACCUSED DEVICE CONTAINS ALL OF THE ELEMENTS AND PERFORMS ALL OF THE OPERATIONS OF THE DEVICE DEFINED BY THE CLAIMS IN ISSUE. THIS IS A COMPLETE FALLACY.

In order to make this point, appellant sets out as follows:

“ ‘(a) After Finding of Fact No. 19 add:

“ ‘The following steps in the performance and use of the tool of the Lane patent in suit, No. 2,029,491, is described in such Lane patent, are identical with the steps in the performance and use of the Johnston accused tool as exemplified by defendant’s Exhibits AH-1, AH-2, and AH-3:

“ ‘1. The elements are assembled into a combined tool including a gun perforator, packer, and tester.

“ ‘2. The combined tool is lowered in the well to the point where it is desired to perforate.

“ ‘3. The gun is fired to perforate the casing.

“ ‘4. Several guns are fired successively.

“ ‘5. The drill pipe is rotated one turn to the left to unlatch the packer and set the slips.

“ ‘6. The weight of the drill pipe is lowered on the slips to set the packer.

“ ‘7. The drill pipe or tubing is open to the formation below the set packer.

“ ‘8. The entrance valve into the tool is left open until a sufficient quantity of the test liquids is secured in the tool. (85)’ (Tr. 78.)”

For the purpose of making an actual comparison in accordance with the testimony so that the Court

will be fully informed and not be misled by the partial facts stated, we make the following comparison of the above steps which actually relate to the apparatus itself and its mode of operation:

3. The gun is fired to perforate the casing.

*The patented device:*

In the patented device the gun is fired by successively sending down charges of compressed air through the drill pipe to the gun which operate an intricate apparatus causing firing of the gun.<sup>1</sup>

*Accused device:*

The gun is fired by turning the drill stem a predetermined number of turns and then allowing the pressure of the mud within the well itself to exert its weight on a firing mechanism of entirely different type and design and mode of operation than that shown in the patent to fire a cartridge and initiate gun fire.<sup>2</sup>

5. The drill pipe is rotated one turn to the left to unlatch the packer and set the slips.

This precise packer was in common use for many years prior to the patent in suit and is the manner of operating prior casing packers.<sup>3</sup>

This precise packer was in common use for many years prior to the patent in suit and is the manner of operating prior casing packers.<sup>3</sup>

6. The weight of the drill pipe is lowered on the slips to set the packer.

This packer was in common use for many years prior to the patent in suit and is the old manner of operating prior casing packers.<sup>3</sup>

This packer was in common use for many years prior to the patent in suit and is the old manner of operating prior casing packers.<sup>3</sup>

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<sup>1</sup>R. 323.

<sup>2</sup>R. 263.

<sup>3</sup>Ex. 17-U, R. 632; Ex. 17-R, R. 613.



7. The drill pipe or tubing is open (opened) to the formation below the set packer.

The drill pipe or tubing is opened to the formation below the packer by firing a bullet through a casing surrounding the apparatus and thus opening a passageway to the formation.<sup>1</sup>

In the accused apparatus a trip valve is arranged interiorly of the apparatus and is opened by means of a go-devil passed downwardly through the drill tubing in a manner entirely foreign to that of the patented apparatus.<sup>2</sup>

8. The entrance valve into the tool is left open until a sufficient quantity of the test liquids is secured in the tool.

There isn't any entrance valve in the tool of the patented device at all, and the entrance of the fluid into the patented device is always left open because, as stated on pages 18-19 of this brief, the later dropping of a ball in an attempt to shut it off in the patented device would not function, so there isn't any valve means at all to effect a closure of that entrance.

In the accused apparatus there is a main valve operative by means of manipulation of the drill pipe to close the entrance to the tool. There isn't any such element in the patented device or anything else that accomplishes its function, so there can be no similarity in construction or in mode of operation.<sup>2</sup>

Steps in the performance and use of the accused tool not found at all in the patented device and, of course, not mentioned by appellant Lane-Wells:

#### Step 9—Preventing contamination of sample by mud.

*(Patented Apparatus)*

No operative provision is provided for the same and the

*(Accused Apparatus)*

After a sample has been taken, the accused apparatus can be

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<sup>1</sup>R. 324.

<sup>2</sup>R. 227.

Court found as a fact<sup>4</sup> that nothing was provided which would prevent the entrance of the mud fluid following the sample and thus destroying the effectiveness of the sample.

closed so as to entirely prevent any mud fluid from following the sample into the tool.<sup>3</sup>

### Step 10—Uncontaminated sample recovered by elevating tool to surface.

No such function can be accomplished by the patented device as the Court found as a fact<sup>5</sup> and therefore, in this regard, the patented apparatus and the accused apparatus have an entirely different construction and mode of operation.

In the accused apparatus, after the tool is closed, the sample can be elevated to the surface for examination by mere removal of the tool from the hole.<sup>3</sup>

### Step 11—Use of additional apparatus or devices unnecessary.

The Court found as a fact<sup>6</sup> that the patented device could not be run into the hole, take a sample and remove the sample to the surface by elevation of the tool itself, but if a sample was to be recovered at all, some auxiliary device or devices not described in the patent must be employed in conjunction with the tool in order to recover the sample. Consequently, there can be no similarity in mode of operation in the two devices.

The accused apparatus is capable of being run into the hole, taking an uncontaminated sample and removing it to the top of the hole for examination without the use of any additional apparatus or devices.<sup>3</sup>

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<sup>3</sup>R. 227, 228, 229, 230, 231.

<sup>4</sup>Finding No. 32, R. 59.

<sup>5</sup>Findings No. 35 and No. 36, R. 59, 60.

<sup>6</sup>Findings No. 35 and No. 36, R. 59, 60.

THE DISTRICT COURT DID NOT (AS CONTENDED BY APPELLANT LANE-WELLS) BASE ITS DECISION OF NON-INFRINGEMENT MERELY ON THE FACT THAT NO PRACTICAL APPARATUS WAS EVER BUILT IN ACCORDANCE WITH THE PATENT, BUT THE DISTRICT COURT IN ADDITION BASED ITS DECISION OF NON-INFRINGEMENT UPON ITS FOLLOWING CONCLUSION<sup>1</sup> "THE ACCUSED APPARATUS BEING SUBSTANTIALLY DIFFERENT BOTH IN CONSTRUCTION AND MODE OF OPERATION FROM THAT DISCLOSED IN THE LANE PATENT NO. 2,029,491 IN SUIT, A CHARGE OF INFRINGEMENT CANNOT BE SUSTAINED", WHICH CONCLUSION WAS BASED ON FINDING OF FACT "THE ACCUSED APPARATUS IS SUBSTANTIALLY DIFFERENT IN CONSTRUCTION AND MODE OF OPERATION FROM THE APPARATUS DISCLOSED IN THE LANE PATENT NO. 2,029,491 IN SUIT".<sup>2</sup>

On page 4 of appellant Lane-Wells' brief is made the dogmatic statement that the "only reason given in the Court's conclusions of law for finding non-infringement" was the fact that the patent must be limited to the precise device shown in the patent only because no apparatus for practical use had been built and commercially used following the teachings of the patent. Then the appellant Lane-Wells proceeds to base its entire brief on this one false premise. That this premise is false is clearly demonstrated by the fact that the Court found as a fact (R. 69, Finding 78):

"The accused apparatus is substantially different in construction and mode of operation from the apparatus disclosed in the Lane patent No. 2,029,491 in suit."

and then in its Conclusions of Law (R. 72, Conclusion 11) concluded as follows:

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<sup>1</sup>Conclusion No. 11, R. 72.

<sup>2</sup>Finding of Fact No. 78, R. 69.

“The accused apparatus being substantially different both in construction and mode of operation from that disclosed in the Lane patent No. 2,029,491 in suit, a charge of infringement cannot be sustained.”

Therefore, the district judge clearly followed not only the law of this circuit, but the law of infringement as it has been laid down since before the turn of the century.

It always has been the rule that to sustain a charge of infringement, there must be *identity of result, identity of the means of attaining that result, and identity of mode of operation*.

In the case of *McDonough v. Johnson-Wentworth Co.*, 30 Fed. (2d) 375, at 383, the Circuit Court of Appeals for the Eighth Circuit said to the test of infringement:

“\* \* \* To sustain the charge of infringement the infringing device must be substantially identical with the one alleged to be infringed in (1) the result attained; (2) the means of attaining that result; and (3) the manner in which its different parts operate and cooperate to produce that result. If the devices are substantially different in either of these respects the charge of infringement is not sustained. (Citing cases.)”

This rule is the same as in this circuit as quoted by Judge Morrow in *American Can Co. v. Hickmott Asparagus Canning Co.*, 137 Fed. 86, in which on pages 88 and 90, respectively, he said:

“In a patented combination, a device in one mechanism, to be the equivalent of a device in another, must perform the same function (*Rowell v. Lindsay*, 113 U.S. 97, 103, 104, 5 Sup. Ct. 507, 28 L. Ed. 906), and perform that function in substantially the same manner, as the thing of which it is alleged to be an equivalent.

\* \* \* \* \*

“To sustain a claim of infringement of a patented machine, three things must be found: First, identity of result; second, identity of means; third, identity of operation. \* \* \*”

This Court of Appeals, in holding non-infringement in *Wilson & Willard Mfg. Co. v. Union Tool Co.*, 249 Fed. 729, continued to follow the same rule as to infringement (at p. 731):

“To make one mechanical device the equivalent of another, it must appear, not only that it produces the same effect, but that such effect is produced by substantially the same mode of operation. \* \* \*”

This Court again in *Pacific States Electric Co. v. Wright* (C.C.A. 9), 277 Fed. 756, in holding the patent sued upon to be not infringed, said:

“\* \* \* And it is well settled law that, if the device embodied in the appellant’s patent can be substantially differentiated from that of the appellee, the charge of infringement cannot be maintained. (Citing cases.)”

Where the mechanism of the alleged infringing device and the device of the patent differ in mode of operation, there can be no infringement. This is set



out in *Measuregraph Co. v. Grand Rapids Show Case Co.* (C.C.A. 8), 29 Fed. (2d) 263, where the Court, in holding a claim expressed broadly in terms of "means" not infringed, said, on page 277:

"\* \* \* The problem was approached in a different way by Vanderveld and he solved it on a different mechanical principle from that disclosed by Hosch and Turner. His mechanism is simple, it embodies a different mode of operation and it is operated in a different way. There is no substantial identity in the means used, but substantial difference between them, and though the purpose to be accomplished and the ultimate results obtained may be the same, this does not constitute infringement. \* \* \*"

Therefore, the District Court was correct and in full accord with the authorities in its Conclusions of Law No. 9 and No. 11 (R. 72):

"9. To sustain a charge of infringement of a patented apparatus, there must be found in the accused apparatus substantial identity of result, substantial identity of means, and substantial identity of mode of operation."

\* \* \* \* \*

"11. The accused apparatus being substantially different both in construction and mode of operation from that disclosed in the Lane patent No. 2,029,491 in suit, a charge of infringement cannot be sustained."

Inasmuch as the finding of fact<sup>1</sup> upon which these conclusions are based is supported by substantial evi-

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<sup>1</sup>Finding of Fact No. 78, R. 69.

dence<sup>2</sup> and no contrary evidence exists, and inasmuch as the question of infringement is a question of fact, the District Court's judgment of non-infringement should not be disturbed. (*Ralph N. Brodie Co. v. The Hydraulic Press Mfg. Co.*, 151 Fed. (2d) 91.)

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**THE DISTRICT COURT NARROWLY CONSTRUED THE CLAIMS ALSO BECAUSE OF THE FACT THAT NO APPARATUS FOR PRACTICAL USE CONSTRUCTED ACCORDING TO THE PATENT HAS EVER BEEN BUILT AND COMMERCIALY USED AND THE REASONS FOR SUCH LACK OF USE UNDOUBTEDLY INFLUENCED THE COURT IN PLACING SUCH A NARROW CONSTRUCTION ON THE PATENT CLAIMS.**

The Court in limiting the claims of the Lane patent to the apparatus illustrated and described by the specifications was influenced so to do by the fact that no such apparatus for practical use has ever been built and commercially used, for the reason *that the Court believed that an apparatus such as disclosed in the patent was of no practical benefit to the industry.* This is definitely and clearly established by Finding of Fact No. 34 (R. 59) of the District Court which states:

“Under normal and usual circumstances as described above in findings Nos. 25-30, the device of the Lane patent in suit, as disclosed therein, would be impractical in industry to recover and bring to the surface of the well a beneficial test sample, without the additional use of other auxiliary

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<sup>2</sup>Testimony of Witness O'Neill on mode of operation of accused apparatus (R. 215-273); on construction and mode of operation of the device of the patent (R. 320-348).

equipment or devices and operations not described or illustrated in the patent, and by a mode of operation not described or illustrated in the patent.”

The reason that the device of the patent in suit is inoperative and impractical as illustrated and described in the patent is that the ball valve 28 (on the drawings of the patent and in the specification thereof) is intended to operate to prevent mud fluid from entering the tester when the packer of the tester is unseated. That ball valve 28 will not so function and consequently the amount of mud which will enter the patented device and its tubing, if it is attempted to elevate such sample to the surface, will be many times the amount of the sample taken into the device and manifestly render such sample useless for any practical purpose. In this regard, the Court found (R. 59):

“32. In the Lane patented device the ball valve 28 will not function to prevent mud fluid from entering the tester when the packer is unseated in normal use of a tester in the oil fields, as described above in findings Nos. 25-30.

“33. Under normal conditions, as described above in findings Nos. 25-30, the amount of mud fluid which will enter the Lane device and its tubing after releasing the packer will be many times the amount of the sample taken into the device and its tubing from the formation.\*

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\*The above Findings are supported by the uncontradicted testimony of the witness Barton at R. 364-367 and the witness O'Neill at R. 326-327, 332, 336-348.



“34. Under normal and usual circumstances as described above in findings Nos. 25-30, the device of the Lane patent in suit, as disclosed therein, would be impractical in industry to recover and bring to the surface of the well a beneficial test sample, without the additional use of other auxiliary equipment or devices and operations not described or illustrated in the patent, and by a mode of operation not described or illustrated in the patent.

“35. The Lane patent in suit fails to disclose a device which is of any practical benefit to the oil industry unless additional auxiliary devices or equipment not described or illustrated in the patent are used in connection therewith, to remove the sample from the device and elevate the sample to the surface of the well.”

From these findings of fact, it is manifestly clear, and the evidence is uncontested and uncontradicted, that the apparatus disclosed in the patent will not by itself constructed and operated as shown in the patent, be capable of producing at the surface of the well a sample which would be of any use at all. In this regard, see the testimony of the unbiased witness Barton, who testified (R. 362) that he was a petroleum engineer with a bachelor of science degree, and was employed by the State of California as senior oil and gas engineer for the last nineteen (19) years.

His testimony on the patent is that if the mud or well fluid can enter the tester following the path of the sample, as set forth in findings of fact Nos. 32 and 33 above set out, that such a tool would be of no prac-

tical benefit in testing a well. His testimony follows (R. 364, 365, 366):

“Q. Speaking of a Johnston tester without the gun, Mr. Barton, and assuming that in a tool of that character no means is provided to exclude the well fluid from entering the tool following the same path that the sample entered in the tool, so that the fluid in the tool and in its tubing always equalized with the mud fluid in the well, in your opinion would or would not such a tool be of any practical benefit in testing a well for water shut-off?

\* \* \* \* \*

“The Witness: My answer to that would have to be no.

“Q. (By Mr. Mellin): And would you state your reasons for your answer, Mr. Barton?

“A. Well, in testing a water shutoff on a string of casing that has been cemented in the well, it is necessary to obtain a sample of fluid which comes into the drill pipe or tubing during the time the valve is open, and which is below the point at which the packer is set. If the fluid behind the drill pipe or tubing were allowed to be equalized after the packer was released, it would be impossible to identify the character of the fluid which entered during the time the valve was open.

“Q. Have you finished your answer, Mr. Barton?

“A. Yes.

“Q. Now, in making a water shutoff test by a tester of the type of the Johnston formation tester, assuming that the packer is tight and set and the tool is open to take a sample, and there-

after the packer is released and the mud fluid in the well under the hydrostatic head has free access to flow into the tool following the taking of the test sample, and the fluid in the tool equalized with the mud fluid in the well bore, in your opinion would or would not such a test be of any practical benefit in determining whether or not a water shutoff had or had not been effected?"

"A. No."

Therefore, having determined that the patent added nothing practical to the art, the Court was correct in construing the patent as narrowly as it possibly could, and obviously when so construed, there could be no infringement by the accused apparatus.

That the Court followed the well established rules of construing patent claims is evident from the authorities hereinafter quoted.

This Court similarly so limited claims in the case of *McRoskey v. Braun Mattress Co.* (C.C.A. 9), 107 Fed. (2d) 143:

"Whether the mattress depressing members of the frames described in the claims are conical-shaped or not, the claims do not state, but, since conical-shaped mattress depressing members are the only ones mentioned in the specification, it must be assumed that the mattress depressing members of the frames described in the claims are likewise conical-shaped. For the claims must be read in the light of the specification. *Henry v. Los Angeles*, 9 Cir., 255 F. 769, 780."

See also:

*Holtzer-Cabot Electric Co. v. Standard Electric Time Co.* (C.C.A. 1), 111 Fed. (2d) 71.

“The plaintiff and defendant attain the same result, but they do it through different means and in different ways. The defendant’s device is not a copy of the thing described in the specification of the patentee, nor is it in substance the same thing. *Burr v. Duryee*, 1 Wall. 531, 17 L. Ed. 650. This is not infringement. To find infringement it must be demonstrated that substantially the same means are employed to accomplish the same result. *E. Van Noorden Co. v. Cheney Co.*, 1 Cir., 75 F. 2d 298; *McDonough v. Johnson-Wentworth Co.*, 8 Cir., 1928, 30 F. 2d 375.

\* \* \* \* \*

“The law is well settled that claims must be construed in the light of the specification and drawings. *Nash Engineering Co. v. Cashin*, 1 Cir., 13 F. 2d 718; *American Fruit Growers, Inc. v. Brogdex Company*, 283 U.S. 1, 51 S. Ct. 328, 75 L. Ed. 801.”

See also:

*Carl Braun, Inc. v. Kendall-Lamar Corporation* (C.C.A. 2), 116 Fed. (2d) 663.

“\* \* \* and as the ‘means’ of the defendant for advancing the cans to cover receiving position is merely that of the prior art it can’t be held the equivalent of the ‘means’ of the claims which are shown by the specifications to be substantially different from that. Where general language is used in a claim it is always to be read as limited by what is new as a patentable advance as shown by the specifications. *Baker Perkins Co. v.*

Thomas Roulston, Inc., 2 Cir., 62 F. 2d 509; Electro Dynamic Co. v. United States Light & H. Corp., 2 Cir., 278 F. 80. Infringement is not proved simply by the language used in a claim without regard to the specifications. It must be proved by showing that the claim covers what is alleged to infringe when the claim is read upon the specifications which describe the invention. Grubman Engineering & Mfg. Co. v. Goldberger, 2 Cir., 47 F. 2d 151; McRoskey v. Braun Mattress Co., 9 Cir., 107 F. 2d 143; Henry v. City of Los Angeles, 9 Cir., 255 F. 769.”

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**THE QUESTION OF INFRINGEMENT IS NOT A VERBAL QUESTION AND CANNOT BE DETERMINED BY THE TEST OF THE WORDS USED IN THE CLAIMS OF THE PATENT IN SUIT.**

The District Court, in limiting the claims to an apparatus having the construction and mode of operation described and illustrated in the specifications, impliedly held that if Lane (patentee) invented anything, it was an apparatus of that particular construction and mode of operation. Consequently, the District Court, then finding that the accused device was entirely different both in construction and mode of operation, correctly found no infringement in fact or in law. That the words of the claims read literally upon the accused apparatus is immaterial under such circumstances. Infringement is not determined by test of the words used in the claims.

The leading authority upon this point is the decision of the United States Supreme Court in *Westinghouse*



*v. Boyden*, 170 U. S. 537, from which the following is quoted:

“The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent.”

This Court of Appeals recognized and approved this rule in *Grant v. Koppl*, 99 Fed. (2d) 106:

“We note that appellant contends that the claims of the patent in suit read upon appellees’ device. We may assume that this is true, especially as to claim 9. But infringement is not a mere matter of words. (Citing cases.)”

This rule is uniformly followed:

In *Electro-Dynamic Co. v. U. S. Light & Heat Corp.* (C.C.A. 2), 278 Fed. 80, 84, Judge Hough wrote:

“It is no longer necessary to multiply citations to show that claims are to be construed in the light of the contribution to knowledge actually made by the inventor, or that mere ability to fit to a thing the words of a claim does not prove infringement. Let it be assumed that (e.g.) the first claim, at least, will ‘read on’ defendant’s system; it remains to inquire whether that (and other) claims, construed consistently with the pat-

entee's actual achievement, justify the finding that there has been that substantial appropriation which is always the essence of the tort known as infringement."

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### CONCLUSION.

We therefore respectfully point out to the Court that the District Court having found as a fact upon substantial and uncontradicted evidence that the patented device and the accused apparatus are entirely different in construction and entirely different in mode of operation, that no infringement could be found either as a matter of fact or as a matter of law.

We also submit that the District Court correctly applied the rules of construction in narrowly construing the claims in the light of the specification to be limited to the precise apparatus there disclosed, and as so limited were not infringed by the accused apparatus. Further, that the Court was correct in so limiting the claims when it found as a fact that the apparatus of the patent added nothing of practical benefit to the art, and in fact found that the device of the Lane patent in suit, as disclosed therein, would be of no practical benefit to the oil industry unless additional auxiliary devices or equipment not described or illustrated in the patent are used in connection therewith, to remove the sample from the device and elevate the sample to the surface of the well.

We respectfully urge that the District Court committed no error in finding and adjudging that the accused apparatus did not infringe the patent in suit.

Dated, San Francisco, California,

April 4, 1949.

Respectfully submitted,

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